



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,399	06/19/2001	Amir Kolsky	M02/3	1307

7590

05/12/2004

DR. D. GRAESER LTD.
c/o THE POLKINGHORNS
9003 FLORIN WAY
UPPER MARLBORO
MARYLAND, MD 20772

EXAMINER

D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,399

Applicant(s)

KOLSKY ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 21 is/are rejected.
- 7) ☒ Claim(s) 7-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for priority to provisional application No. 60/212628, filed on 6/19/2000

Drawings

The drawings were received on 6-19/2001 and have been reviewed by the draftsperson and examiner.

1. **Figures 1, 2a and 2b** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

Claim Objections

Claims 7-20 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). **Accordingly, the claims 7-20 have not been further treated on the merits.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 21 rejected under 35 U.S.C. 102(e) as being anticipated by Shobatake et al. US 6,654,607 (hereafter Shobatake).

As per **claim 1**, Shobatake teaches a method for providing access to a resource through an access network with an access device (C3, L60-63), comprising:

Associating the resource with an object identifier (C3, L63 to C4, L3)

Transmitting a request with said object identifier to an access resource with the access device through the access network AND Resolving said request to identify the resource according to said object identifier AND Accessing the resource with the access device if said request is resolved (C3, L4-L22, C6, 40-53 and figures 1-16).

As per **claim 21**, Shobatake teaches any of claims 9-15 wherein said request is sent according to PSTN/ISDN format (figure 1C shows connection to PSTN/ISDN, #117).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Shobatake as applied to claim 1 and further in view of Kikinis US 6,243,596 (hereafter Kikinis).

As per **claim 2**, Shobatake teaches claim 1 wherein said request is transmitted according to a first mode through the access network, while the resource is accessed according to a second mode through the access network (C4, L11-15 and C6, L37-53 teach the ability to translate from one mode/protocol to another) **but is silent on** such that accessing the resource causes the access device to switch from said first mode to said second mode.

Kikinis teaches a cell phone with the capability to access the Internet (title and abstract). The examiner notes that this functionality reads on the portion of the claim Shobatake is silent on since Kikinis' phone connects to an ISP via voice connection but then must be capable of transmitting/receiving digital data when browsing the Internet.

It would have been obvious to one skilled in the art at the time of the invention to modify Shobatake, such that the device is requested to switch from first to second mode, to provide to connect the user to different networks (eg. from a voice system to a packet-based system).

As per **claim 3**, Shobatake teaches claim 2 **but is silent on** wherein the access device is forced to switch from said first mode to said second mode.

Kikinis teaches a cell phone with the capability to access the Internet (title and abstract). The examiner notes that this functionality reads on the portion of the claim Shobatake is silent on since Kikinis' phone connects to an ISP via voice connection and is forced to transmit/receive digital data when browsing the Internet.

It would have been obvious to one skilled in the art at the time of the invention to modify Shobatake, such that the device is requested to switch from first to second mode, to provide to connect the user to different networks (eg. from a voice system to a packet-based system).

As per **claim 4**, Shobatake teaches claim 2 **but is silent on** wherein the access device is requested to switch from said first mode to said second mode.

Shobatake (figure 9) shows an overview of two mobile units that may potentially communicate (Terminal A, caller and Terminal B, callee) as well as calls between various platforms (figure 11). Since Shobatake teaches a UMM that can translate addresses/protocols among the different networks (C4, L11-15 and C6, L37-53), one skilled would provide for software that would request a switch from a first mode to a second mode if the two callers were using different protocols.

It would have been obvious to one skilled in the art at the time of the invention to modify Shobatake, such that the device is requested to switch from first to second mode, to provide to connect the user to different networks (eg. from a voice system to a packet-based system).

As per multi-dependent **claim 5/1**, Shobatake teaches claim 1, wherein resolving said request includes identifying a user of the access device (Abstract, figure 6 shows ID for Callee as "doug.domainname.com" and (AAA) BBB-CCCC or "bob.domainname.com **and/or** figure 11 shows the system tracks a caller's alias/address, eg. Caller's alias for Platform A = www.xxx.yyy.zzz AND figure 3 shows an Alias database, #305-#308 to store aliases **and/or** C5, L58-65).

Art Unit: 2683

As per multi-dependent **claim 5/2/1** , Shobatake teaches any of claims 1 and 2 wherein resolving said request includes identifying a user of the access device (Abstract, figure 6 shows ID for Callee as "doug.domainname.com" and (AAA) BBB-CCCC or "bob.domainname.com **and/or** figure 11 shows the system tracks a caller's alias/address, eg. Caller's alias for Platform A = www.xxx.yyy.zzz AND figure 3 shows an Alias database, #305-#308 to store aliases **and/or** C5, L58-65).

As per multi-dependent **claim 5/4/2/1** , Shobatake teaches any of claims 1, 2 and 4 wherein resolving said request includes identifying a user of the access device (Abstract, figure 6 shows ID for Callee as "doug.domainname.com" and (AAA) BBB-CCCC or "bob.domainname.com **and/or** figure 11 shows the system tracks a caller's alias/address, eg. Caller's alias for Platform A = www.xxx.yyy.zzz AND figure 3 shows an Alias database, #305-#308 to store aliases **and/or** C5, L58-65).

As per multi-dependent **claim 5/3/2/1** , Shobatake teaches any of claims 1, 2 and 3 wherein resolving said request includes identifying a user of the access device (Abstract, figure 6 shows ID for Callee as "doug.domainname.com" and (AAA) BBB-CCCC or "bob.domainname.com **and/or** figure 11 shows the system tracks a caller's alias/address, eg. Caller's alias for Platform A = www.xxx.yyy.zzz AND figure 3 shows an Alias database, #305-#308 to store aliases **and/or** C5, L58-65).

As per **claim 6**, Shobatake teaches multi-dependent claim 5 wherein said user is identified for using the access network with a user identification, such that said user is identified when resolving said request with said user identification for the access network (Abstract, figure 6 shows ID for Callee as "doug.domainname.com" and (AAA) BBB-CCCC or "bob.domainname.com **and/or** figure 11 shows the system tracks a caller's alias/address, eg. Caller's alias for Platform A = www.xxx.yyy.zzz AND figure 3 shows an Alias database, #305-#308 to store aliases **and/or** C5, L58-65).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Isomursu et al. US 6,370,389.
2. Purcell et al. WO 98/02011
3. Saxena US 6,370,132
4. Gossman et al. US 6,181,935
5. Sakurai et al. US 6,600,930

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta

